

REMARKS

In reply to the Final Office Action mailed November 1, 2006, Applicants have amended claims 28, 36-38 and 40-43. Claims 1-10 were previously cancelled and claims 11-27 were withdrawn by the Examiner. Claims 28-44¹ are currently under examination.

In the Final Office Action², the Examiner rejected claims 40-43 under 35 U.S.C. § 112, first paragraph, for containing subject matter which was not described in the specification in such a way to as to reasonably convey to one skilled in the art that the inventors, at the time the application was file, had possession of the claimed invention.

The Examiner also rejected claims 28 and 34-37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,019,364 to Syvatsky et al. ("Syvatsky"); rejected claims 28 and 34-38 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,363,971 to Weeks et al. ("Weeks"); rejected claims 31, 28 and 34-39 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of U.S. Patent No. 5,293,319 to DeShe et al. ("DeShe"); rejected claims 28, 34-38 and 40-41 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of U.S. Patent No. 4,136,780 to Hunter et al. ("Hunter"); rejected claims 28, 34-38, and 42 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of U.S. Patent No. 2,936,556 to Gibson; rejected claims 28, 34-39 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in

¹ As renumbered by the Examiner shown in the image file wrapper, and as provided in the final office action dated November 1, 2006.

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

view of Syvatsky; rejected claims 28, 34-38, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of U.S. Patent No. 5,535,127 to Uno et al. ("Uno"); rejected claims 28, 34-38, and 44 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of U.S. Patent No. 4,992,649 to Mampe et al. ("Mampe"); rejected claims 30, 28, and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over Syvatsky in view of DeShe; rejected claims 29-30 and 32-33 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of U.S. Patent No. 6,549,892 to Sansone; rejected claims 28-30 and 32-37 under 35 U.S.C. § 103(a) as being unpatentable over Syvatsky in view of Sansone; rejected claims 28-30, 32-38, and 44 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of U.S. Patent No. 5,079,714 to Manduley; rejected claims 28-30 and 32-37 under 35 U.S.C. § 103(a) as being unpatentable over Syvatsky in view of Manduley, and rejected claims 38-41 under 35 U.S.C. § 103(a) as being unpatentable over Syvatsky in view of Hunter.

I. Regarding the rejection of claims 40-43 under 35 U.S.C. § 112, 1st paragraph

Claims 40-43 are rejected under 35 U.S.C. § 112, first paragraph, as failing to show possession at the time of filing of the claimed subject matter (OA page 3). Applicant respectfully traverses the rejection of claims 40-43 under 35 U.S.C. §112, 1st paragraph. However, to expedite prosecution, Applicants have amended claims 40-43 as summarized below.

Claim 40 is amended to recited, ". . . wherein the first altitude is at least eight feet, six inches." Support for this claim amendment is found on page 7, numbered section 3.3.4, of provisional U.S. Patent Application Serial No. 60/250,146,

("146 provisional"), which is incorporated by reference and from which the present application claims priority.

Claim 41 is amended to recited, ". . . wherein the first altitude is reached by the upward module in a maximum horizontal displacement 6 feet. Support for this claim amendment is found on page 6, numbered section 3.2.3 of the '146 provisional.

Claim 42 is amended to recited, ". . . wherein the first is at an overhead height which enables passage underneath." Support for this claim amendment is found on page 4, numbered section 1.0, of the '146 provisional.

Claim 43 is amended to recited, ". . . wherein the delivery fee verifier checks for postage." Support for this claim amendment is found at paragraph 21, line 2 of the specification.

Possession of the subject matter claimed in claims 40-43 at the time of filing is supported by the specification as, for example, identified above. Therefore, withdrawal of the rejection of claims 40-43 under 35 U.S.C. § 112, first paragraph, is respectfully requested.

II. Regarding the rejection of claims 28 and 34-37 under 35 U.S.C. § 102(b) as being anticipated by Syvatsky

Applicants respectfully traverse the rejection of claims 28 and 34-37 under 35 U.S.C. § 102(b) as being anticipated by Syvatsky. In order to properly anticipate claims 28 and 34-37 under 35 U.S.C. § 102(b), the cited reference must explicitly disclose each and every limitation recited in the claims. See M.P.E.P. § 2131 (8th ed., Aug. 2005 rev.). If the cited reference, however, fails to expressly set forth a particular limitation, then the Examiner must show that this limitation is inherently disclosed to

substantiate a claim of anticipation. See *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). To establish inherency, the Examiner must specifically identify extrinsic evidence that makes clear to one skilled in the art that the missing limitation "is necessarily present" in the reference's disclosure. See *id.*; see also *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

Claim 28 recites a combination including, for example:

sending, via an upward module, the mail pieces from the postage verifier to the overhead transport;

receiving the mail pieces by the overhead transport;

transporting the mail pieces through the overhead transport;

sending, via the downward module, the mail pieces from the overhead transport to the mail sorter.

Syvatsky discloses a document transporting and processing system, which includes a document infeed station 12 at one end, a document sorter 14, a transport path 16, and a 90 degree right angle turn 36. (col. 4, line 66 to col. 5, line 38; Fig. 1). Syvatsky discloses re-orienting devices 52A-52C. (col. 5, lines 56-58; Fig. 2). Syvatsky fails to disclose an overhead transport. Syvatsky discloses checking for documentation orientation and correction of the same throughout a processing system, but fails to disclose an overhead transport path anywhere in the transporting and processing system. Although Syvatsky references a right angle turn in transport path, Syvatsky fails to disclose any overhead transport or any connections to the same.

Syvatsky at least fails to disclose, teach, or suggest, "sending, via an upward module, the mail pieces from the postage verifier to the overhead transport; receiving

the mail pieces by the overhead transport; transporting the mail pieces through the overhead transport; [and] sending, via the downward module, the mail pieces from the overhead transport to the mail sorter.”

Accordingly, Syvatsky cannot anticipate claim 28 for at least the above reasons. Claims 34-37 depend from claim 28 and are not anticipated by Syvatsky for at least the same reasons as claim 28.

III. Regarding the rejection of claims 28 and 34-38 under 35 U.S.C. § 102(b) as being anticipated by Weeks

Applicants respectfully traverse the rejection of claims 28 and 34-38 under 35 U.S.C. § 102(b) as being anticipated by Weeks.

Claim 28 recites a combination including, for example:

sending, via an upward module, the mail pieces from the postage verifier to the overhead transport;

receiving the mail pieces by the overhead transport;

transporting the mail pieces through the overhead transport;

sending, via the downward module, the mail pieces from the overhead transport to the mail sorter.

Weeks discloses a sorting machine, which sorts mail using a reduced number of stackers through multiple passes. (Abstract, col. 2, lines 10-15; col. 3, lines 65-67; col. 4, lines 24-25; Fig. 1). Weeks discloses, “After the mail leaves the reader 24, it is transported to the top section where it is further transported to the appropriate stacker and gated off.” (col. 7, lines 16-19). However, Weeks fails to disclose, teach, or suggest an overhead transport and “transporting the mail pieces through the overhead transport, as recited in claim 28.” By contrast, top section taught by Weeks is above the

stackers (Fig. 2). “When the gate diverter solenoid is actuated, it pushes a pivoting roller 32 against the transport belt in the direction of the stacker. The transport belt, which is elastic, deflects when the roller is pushed against it –diverting the mail piece into the stacker.” (col. 7, lines 24-29; Fig. 2; see also Fig. 1, arrows 1-13). Accordingly, the top section, including the elastic transport belt are above the stacker, but are clearly not overhead.

Therefore, Weeks at least fails to disclose “sending, via an upward module, the mail pieces from the postage verifier to the overhead transport; receiving the mail pieces by the overhead transport; transporting the mail pieces through the overhead transport; sending, via the downward module, the mail pieces, from the overhead transport to the mail sorter as recited in claim 28.

For at least the above reasons, Weeks cannot anticipate claim 28. Claims 34-37 depend from claim 28 and are not anticipated by Weeks for at least the same reasons as claim 28.

Independent claim 38 while of different scope, recites limitations similar to those of claim 28 and, thus, is allowable over Weeks for at least the same reasons discussed above with respect to claim 28.

IV. Regarding the rejection of claims 31, 28, and 34-39 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of DeShe

Applicants respectfully traverse the rejection of claims 31, 28, and 34-39 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of DeShe because a prima facie case of obviousness has not been established.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." M.P.E.P. § 2142, 8th Ed., Rev. 4 (October 2005), p. 2100-134.

Claims 31 and 34-37, and 39 depend from claims 28 and 38, respectively, and thus require each and every element of their respective independent claims. As demonstrated above, Weeks fails to teach or suggest each and every element required by independent claim 28 and fails to teach or suggest each and every similar element required by independent 38. Secondary reference DeShe fails to compensate for the deficiencies of Weeks. That is, DeShe also fails to teach or suggest at least:

- sending, via an upward module, the mail pieces from the postage verifier to the overhead transport;
- receiving the mail pieces by the overhead transport;
- transporting the mail pieces through the overhead transport;
- sending, via the downward module, the mail pieces from the overhead transport to the mail sorter,

as recited in claim 28.

DeShe teaches a system consisting of "three stages", a "printing stage," a "reading stage," and a "delivery sort/verification stage." (Fig. 1; col. 3, lines 59-64). "[T]ransverse roller 98" and "sensing stations 110 . . . [are] located at appropriate locations along the transport mechanism 90." (col. 7, lines 52-53; col. 7, lines 56-58). DeShe fails, for example, to teach or suggest "transporting mail pieces through an overhead transport" (emphasis added). DeShe fails to compensate for the deficiencies

in Weeks. For at least this reason, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 31 and 34-37 are allowable at least by virtue of their dependence from claim 28. Claim 38, while different in scope recited elements similar to claim 28 and is patentable over Weeks in view of DeShe for at least the same reasons discussed above for claim 28. Dependent claim 39 is allowable at least by virtue of its dependence from claim 38.

V. Regarding the rejection of claims 28, 34-38, and 40-41 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of Hunter

As demonstrated above, Weeks fails to teach or suggest each and every element required by independent claims 28 and 38. Secondary reference Hunter fails to compensate for the deficiencies of Weeks. That is, Hunter also fails to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier
to the overhead transport;
receiving the mail pieces by the overhead transport;
transporting the mail pieces through the overhead transport;
sending, via the downward module, the mail pieces from the overhead
transport to the mail sorter,
as recited in claim 28.

Hunter teaches delivering mail “toward a viewing station 11 by means of an elevator conveyor 25 (Fig. 10) which may extend to a floor below that on which the viewing station is located as indicated in Fig. 1.” (col. 4, lines 54-58: Figs. 1 and 10).

Hunter fails, for example, to teach or suggest “transporting the mail pieces through an overhead transport” (emphasis added). Accordingly, Hunter fails to

compensate for the deficiencies in Weeks. For at least this reason, a *prima facie* case of obviousness has not been established for claims 34-37 are allowable at least by virtue of their dependence from claim 28. Claim 38, while different in scope, recites elements similar to claim 28 and is allowable over Weeks in view of Hunter for at least the same reasons discussed above for claim 28. Dependent claims 40-41 are allowable at least by virtue of their dependence from claim 38.

VI. Regarding the rejection of claims 28, 34-38, and 42 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of Gibson.

As demonstrated above, Weeks fails to teach or suggest each and every element required by independent claims 28 and 38. Secondary reference Gibson fails to compensate for the deficiencies of Weeks. That is, Gibson also fails to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier
to the overhead transport;
receiving the mail pieces by the overhead transport;
transporting the mail pieces through the overhead transport;
sending, via the downward module, the mail pieces from the overhead
transport to the mail sorter,
as recited in claim 28.

Gibson teaches a mail singulation and culling system. More particularly, Gibson teaches that “[t]he basic elements of the system include the vibrating hopper 10, inclined conveyor 12, receiving stations 14 . . . size detection stations 52, . . . the letter stacker 24, . . . and the gagging roller 28.” (col. 3, lines 6-14). The inclined conveyor 12 is shown in Fig. 1 and is “. . . similar to that used in the aforementioned Model 500B

Edge Feeder.” (col. 4, lines 61-63; Fig. 1). The inclined conveyor is clearly not an overhead transport. Accordingly, Gibson clearly fails to teach or suggest “sending, via an upward module the mail pieces from the postage verifier to the overhead transport; receiving the mail pieces by the overhead transport; transporting the mail pieces through the overhead transport; sending, via the downward module, the mail pieces from the overhead transport to the mail sorter.” (emphasis added).

For at least the above reasons, Gibson fails to compensate for the deficiencies in Weeks. Therefore, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 34-37 are allowable at least by virtue of their dependence from claim 28. Claim 38, while different in scope, recites elements similar to claim 28 and is allowable over Weeks in view of Gibson for at least the same reasons discussed above for claim 28. Dependent claim 42 is allowable at least by virtue of its dependence from claim 38.

VII. Regarding the rejection of claims 28, 34-39, and 44 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of Syvatsky

As demonstrated above, Weeks fails to teach or suggest each and every element required by independent claims 28 and 38. Also demonstrated above, secondary reference Syvatsky fails to compensate for the deficiencies of Weeks. That is, Syvatsky also fails to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier
to the overhead transport;
receiving the mail pieces by the overhead transport;
transporting the mail pieces through the overhead transport;

sending, via the downward module, the mail pieces from the overhead transport to the mail sorter,
as recited in claim 28.

For at least the above reasons, a *prima facie* case of obviousness has not been established for claim 28. Dependent claims 34-37 are allowable at least by virtue of their dependence from claim 28. Claim 38, while different in scope, recites elements similar to claim 28 and is allowable over Weeks in view of Syvatsky for at least the same reasons discussed above for claim 28. Dependent claims 39 and 44 are allowable at least by virtue of their dependence from claim 38.

VIII. Regarding the rejection of claims 28, 34-38, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of Uno

As demonstrated above, Weeks fails to teach or suggest each and every element required by independent claims 28 and 38. Uno fails to compensate for the deficiencies of Weeks. That is, Uno also fails to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier to the overhead transport;
receiving the mail pieces by the overhead transport;
transporting the mail pieces through the overhead transport;
sending, via the downward module, the mail pieces from the overhead transport to the mail sorter,
as recited in claim 28.

Uno teaches “an automatic mail processing apparatus [comprising] a physical quantity detection section , , , [and] a postage determining section.” (abstract). Uno further teaches an automated method for determining the amount of postage required.

"[M]ail taken out of mail feeder 201 and conveyed by the transport belt 202 is illuminated by a light source 203." (col. 4, lines 23-26; Fig. 2). However, Uno fails to teach or suggest "sending, via an upward module, the mail pieces from the postage verifier to the overhead transport; receiving the mail pieces by the overhead transport; transporting the mail pieces through the overhead transport; sending, via the downward module, the mail pieces from the overhead transport to the mail sorter," as recited in claim 28 (emphasis added).

For at least the above reasons, Uno and Weeks, taken individually or in combination, do not teach or suggest each and every element of claim 28. Therefore, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 34-37 are allowable at least by virtue of their dependence from claim 28. Claim 38, while different in scope, recites elements similar to claim 28 and is allowable over Weeks in view of Uno for at least the same reasons discussed above for claim 28. Dependent claim 43 is allowable at least by virtue of its dependence from claim 38.

IX. Regarding the rejection of claims 28, 34-38, and 44 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of Mampe

As demonstrated above, Weeks fails to teach or suggest each and every element required by independent claims 28 and 38. Secondary reference Mampe fails to compensate for the deficiencies of Weeks. That is, Mampe also fails to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier
to the overhead transport;

receiving the mail pieces by the overhead transport;
transporting the mail pieces through the overhead transport;
sending, via the downward module, the mail pieces from the overhead
transport to the mail sorte,
as recited in claim 28.

Mampe teaches "remote video scanning" to improve efficiency of personnel and utilization of optical scanner recognition systems. (col. 2, lines 9-34). Mampe further teaches that "[t]he item is singulated and fed down a mechanical transport feeder 1. (col. 2, lines 64-66; Fig. 1). However, Mampe fails to teach or suggest "sending, via an upward module, the mail pieces from the postage verifier to the overhead transport; receiving the mail pieces by the overhead transport; transporting the mail pieces through the overhead transport; sending, via the downward module, the mail pieces from the overhead transport to the mail sorter," as recited in claim 28 (emphasis added).

For at least the above reasons, Mampe and Weeks, taken individually or in combination, do not teach or suggest each and every element of claim 28. Therefore, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 34-37 are allowable at least by virtue of their dependence from claim 28. Claim 38, while different in scope, recites elements similar to claim 28 and is allowable over Weeks in view of Mampe for at least the same reasons discussed above for claim 28. Dependent claim 44 is allowable at least by virtue of its dependence from claim 38.

X. Regarding the rejection of claims 30, 28, and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over Syvatsky in view of DeShe

As demonstrated above, Syvatsky fails to teach or suggest each and every element required by independent claim 28. As also demonstrated above, secondary

reference DeShe fails to compensate for the deficiencies of Syvatsky. That is, Syvatsky and DeShe, either alone or combination, fail to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier
to the overhead transport;

receiving the mail pieces by the overhead transport;

transporting the mail pieces through the overhead transport;

sending, via the downward module, the mail pieces from the overhead
transport to the mail sorter,

as recited in claim 28.

For at least this reason, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 30 and 34-37 are allowable at least by virtue of their dependence from claim 28.

XI. Regarding the rejection of claims 29-30 and 32-33 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of Sansone

Claims 29-30 and 32-33 require the elements of claim 28 by virtue of their dependence from claim 28. As demonstrated above, Weeks fails to teach or suggest each and every element required by independent claim 28. Secondary reference Sansone fails to compensate for the deficiencies of Weeks. That is, Sansone also fails to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier
to the overhead transport;

receiving the mail pieces by the overhead transport;

transporting the mail pieces through the overhead transport;

sending, via the downward module, the mail pieces from the overhead transport to the mail sorter,
as recited in claim 28.

Sansone teaches “assigning a unique code to each recipient” to reduce the number of undeliverable mail pieces. (col. 2, lines 19-26). However, Sansone fails to teach or suggest “sending, via an upward module, the mail pieces from the postage verifier to the overhead transport; receiving the mail pieces by the overhead transport; transporting the mail pieces through the overhead transport; sending, via the downward module, the mail pieces from the overhead transport to the mail sorter,” as recited in claim 28 (emphasis added).

Sansone fails to compensate for the deficiencies in Weeks. For at least this reason, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 29-30 and 32-33 are allowable at least by virtue of their dependence from claim 28.

XII. Regarding the rejection of claims 28-30 and 32-37 under 35 U.S.C. § 103(a) as being unpatentable over Syvatsky in view of Sansone

As demonstrated above, Syvatsky fails to teach or suggest each and every element required by independent claim 28. As also demonstrated above, secondary reference Sansone fails to compensate for the deficiencies of Syvatsky. That is, Syvatsky and Sansone, either alone or combination, fail to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier to the overhead transport;

receiving the mail pieces by the overhead transport;

transporting the mail pieces through the overhead transport;

sending, via the downward module, the mail pieces from the overhead transport to the mail sorter,
as recited in claim 28.

For at least this reason, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 29-30 and 32-37 are allowable at least by virtue of their dependence from claim 28.

XIII. Regarding the rejection of claims 28-30, 32-38, and 44 under 35 U.S.C. § 103(a) as being unpatentable over Weeks in view of Manduley

As demonstrated above, Weeks fails to teach or suggest each and every element required by independent claims 28 and 38. Secondary reference Manduley fails to compensate for the deficiencies of Weeks. That is, Manduley also fails to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier to the overhead transport;
receiving the mail pieces by the overhead transport;
transporting the mail pieces through the overhead transport;
sending, via the downward module, the mail pieces from the overhead transport to the mail sorter,
as recited in claim 28.

Manduley teaches “a method and process for improving mail deliverability [and database processing].” (abstract; title). However, Manduley fails to teach or suggest “sending, via an upward module, the mail pieces from the postage verifier to the overhead transport; receiving the mail pieces by the overhead transport; transporting the mail pieces through the overhead transport; sending, via the downward module, the

mail pieces from the overhead transport to the mail sorter,” as recited in claim 28 (emphasis added).

Manduley fails to compensate for the deficiencies in Weeks. For at least this reason, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 29-30 and 32-37 are allowable at least by virtue of their dependence from claim 28. Claim 38, while different in scope, recites elements similar to claim 28 and is allowable over Weeks in view of Manduley for at least the same reasons discussed above for claim 28. Dependent claim 44 is allowable at least by virtue of its dependence from claim 38.

XIV. Regarding the rejection of claims 28-30 and 32-37 under 35 U.S.C. § 103(a) as being unpatentable over Syvatsky in view of Manduley

As demonstrated above, Syvatsky fails to teach or suggest each and every element required by independent claim 28. And also as demonstrated above, secondary reference Manduley fails to compensate for the deficiencies of Manduley. That is, Manduley also fails to teach or suggest at least:

sending, via an upward module, the mail pieces from the postage verifier
to the overhead transport;
receiving the mail pieces by the overhead transport;
transporting the mail pieces through the overhead transport;
sending, via the downward module, the mail pieces from the overhead
transport to the mail sorter,
as recited in claim 28.

Manduley teaches “a method and process for improving mail deliverability [and database processing].” (abstract; title). However, Manduley fails to teach or suggest

“sending, via an upward module, the mail pieces from the postage verifier to the overhead transport; receiving the mail pieces by the overhead transport; transporting the mail pieces through the overhead transport; sending, via the downward module, the mail pieces from the overhead transport to the mail sorter,” as recited in claim 28 (emphasis added).

Manduley fails to compensate for the deficiencies of Syvatsky. For at least this reason, a *prima facie* case of obviousness has not been established for claim 28 and dependent claims 29-30 and 32-37 are allowable at least by virtue of their dependence from claim 28.

XV. Regarding the rejection of claims 38-41 under 35 U.S.C. § 103(a) as being unpatentable over Syvatsky in view of Hunter

As demonstrated above, Syvatsky fails to teach or suggest each and every element required by independent claim 38. Also, as demonstrated above, secondary reference Hunter fails to compensate for this deficiency. That is, Syvatsky fails to teach or suggest at least:

transporting the received delivery item from the output of the delivery item processing machine up to a first altitude that avoids interference with a work area via a processor-controlled upward module mechanical subsystem to an overhead transport module;

receiving the delivery item by the overhead transport module and transporting the delivery item, at the first altitude, via a processor-controlled overhead transport module mechanical subsystem to a downward module;

receiving the delivery item by the downward module and transporting the delivery item from the first altitude to a second altitude via the downward module, wherein the downward module is processor-controlled; and transporting the delivery item via the downward module to an input of the sorter at the second altitude,

as recited in claim 38.

Syvatsky discloses a document transporting and processing system, which includes a document infeed station 12 at one end, a document sorter 14, a transport path 16, and a 90 degree right angle turn 36. (col. 4, line 66 to col. 5, line 38; Fig. 1). Syvatsky discloses re-orienting devices 52A-52C. (col. 5, lines 56-58; Fig. 2). Syvatsky fails to disclose an overhead transport. Syvatsky discloses checking for documentation orientation and correction of the same throughout a processing system, but fails to disclose an overhead transport path anywhere in the transporting and processing system. Syvatsky references a right angle turn in transport path but fails to disclose any overhead transport or any connections to the same.

Hunter teaches "mail is delivered toward a viewing station 11 by means of an elevator conveyor 25 (Fig. 10) which may extend to a floor below that on which the viewing station is located as indicated in Fig. 1." (col. 4, lines 54-58; Figs. 1 and 10). However, Hunter fails, for example, to teach or suggest "transporting the mail pieces through an overhead transport" (emphasis added). Accordingly, Hunter fails to compensate for the deficiencies of Syvatsky. For at least this reason, a *prima facie* case of obviousness has not been established for claim 38 and dependent claims 39-41 are allowable at least by virtue of their dependence from claim 38.

XVI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: Amelia F. Morani
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Dated: April 26, 2007